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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/849,509	05/19/2004	Laurence C. Mudge	0624-4129	6774

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MORGAN & FINNEGAN, L.L.P.  
3 WORLD FINANCIAL CENTER  
NEW YORK, NY 10281-2101

EXAMINER
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PRYOR, ALTON NATHANIEL

ART UNIT	PAPER NUMBER
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1616

NOTIFICATION DATE	DELIVERY MODE
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07/07/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOPatentCommunications@Morganfinnegan.com  
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<b>Office Action Summary</b>	<b>Application No.</b> 10/849,509	<b>Applicant(s)</b> MUDGE, LAURENCE C.	
	<b>Examiner</b> ALTON N. PRYOR	<b>Art Unit</b> 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 4/29/08;5/29/08.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8,10-17,20-35,37 and 38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8,10-17,20-35,37,38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Applicant's arguments, see papers, filed 4/29/08 and 5/29/08, with respect to claims and oath have been fully considered and are persuasive. The objection and rejections of 4/29/08 and 5/29/08 have been withdrawn.

Applicant's arguments, see papers, filed 4/29/08 and 5/29/08, with respect to the rejection(s) of claim(s) 1-8,10-17,20-35,37,38 under Obviousness type double have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made below.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8,10-17,20-35,37,38 are no longer rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-40 of U.S. Patent No. 5643852. Although the conflicting claims are not identical, they are not patentably distinct from

each other because both instant claims and claims in USPN 5643852 are to inventions comprising the treatment of turfgrass (bentgrass and bermudagrass) with a composition comprising a monoester salt of a phosphorous acid and phthalocyanine such as pigment blue 15. The inventions differ from one another in that instant invention excludes mancozeb. Although the patented claims do not specifically exclude mancozeb, the patented claims do not make mancozeb a required component. Therefore patented claims like instant claims can be free of mancozeb. For this reason, USPN '852 makes obvious the instant claims.

Claims 1-8,10-17,20-35,37,38 are no longer rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 5665672. Although the conflicting claims are not identical, they are not patentably distinct from each other because both instant claims and claims in USPN 5665672 are to inventions comprising the treatment of turfgrass (bentgrass and bermudagrass) with a composition comprising a monoester salt of a phosphorous acid and phthalocyanine such as pigment blue 15. The inventions differ from one another in that instant invention excludes mancozeb. Although the patented claims do not specifically exclude mancozeb, the patented claims do not make mancozeb a required component. Therefore patented claims like instant claims can be free of mancozeb. For this reason, USPN '672 makes obvious the instant claims.

Claims 1-8,10-17,20-35,37,38 are no longer rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 5336661 in view of Nesteruk et al (PL 103345; 5/31/79). Although the conflicting claims are not identical, they are not patentably distinct from each other because both instant claims and claims in USPN 5336661 are to inventions comprising the treatment of turfgrass (bentgrass and

bermudagrass) with a composition comprising a monoester salt of a phosphorous acid. The inventions differ from one another in that instant invention excludes mancozeb. Also USPN '661 does not make claim to an invention comprising phthalocyanine compounds such as pigment blue 15 as instantly claimed. However, Nesteruk discloses that pigment blue is present in fungicidal compositions for staining purposes. With respect to the instant claims lacking a phthalocyanine compound such as pigment blue 15, it would have been obvious to modify the claims of USPN '661 to include the pigment blue compound recited in the instant claims. One would have been motivated to do this since PL '345 discloses that pigment blue is applied for the purpose of marking a location. Although the patented claims do not specifically exclude mancozeb, the patented claims do not make mancozeb a required component. Therefore patented claims like instant claims can be free of mancozeb. For the above reasons, USPN '661 in view of PL '345 makes obvious the instant claims.

*Response to Applicants' Amendment*

Instant independent claims 1,10,24 and 32 have been amended to exclude “an ethylenebisdithiocarbamate contact fungicide” whereas claims in cited USPNS require “an ethylenebisdithiocarbamate contact fungicide”. This difference recited in presently amended claims removes the double patenting rejections.

***Objection to Oath under 37 CFR 1.175 and MPEP § 1414***

The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following: One cannot file supplemental oaths unless the original oath is correct. In the instant case the original oath is defective because the phrase “and first” is missing from the correct oath phrase: “is the original and first inventor”.

To correct the oath problem, it is suggested that the Applicants complete and submit oath MPEP form PTO/SB52 (10-05).

***Claim rejection under 35 U.S.C. 251***

Claims 1-8, 10-17, 20-35,37,38 are rejected as being based upon a defective reissue oath under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the oath is set forth in the discussion above in this Office action.

***Objection under 37 CFR 3.73***

The present 3.73 form is objected to. The Applicants must provide a separate 3.73(b) form which cannot be part of a defective oath. Please submit another 3.73(b) form stating that the Applicant's are 100% owners.

The following is a statement of 37 CFR 3.73:

**37 CFR 3.73 Establishing right of assignee to take action.**

(a) The inventor is presumed to be the owner of a patent application, and any patent that may issue therefrom, unless there is an assignment. The original applicant is presumed to be the owner of a trademark application or registration unless there is an assignment.

(b)(1) In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:

(i) Documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment). For trademark matters only, the documents submitted to establish ownership may be required to be recorded pursuant to § 3.11 in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office. For patent matters only, the submission of the documentary evidence must be accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant § 3.11; or

(ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

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(2) The submission establishing ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by:

(i) Including a statement that the person signing the submission is authorized to act on behalf of the assignee; or

(ii) Being signed by a person having apparent authority to sign on behalf of the assignee, *e.g.*, an officer of the assignee.

(c) For patent matters only:

(1) Establishment of ownership by the assignee must be submitted prior to, or at the same time as, the paper requesting or taking action is submitted.

(2) If the submission under this section is by an assignee of less than the entire right, title and interest, such assignee must indicate the extent (by percentage) of its ownership interest, or the Office may refuse to accept the submission as an establishment of ownership.

Enclosed with this Office action is a sample Statement under 37 CFR 3.73(b) which an assignee may use in order to ensure compliance with the Rule. Part A of the Statement is used when there is a single assignment from the inventor(s). Part B of the Statement is used when there is a chain of title. The “Copies of assignments...” box should be checked when the assignment document(s) (set forth in part A or part B) is/are not recorded in the Office, and a copy of the assignment document(s) is/are attached. When the “Copies of assignments...” box is checked, either the part A box or the part B box, as appropriate, must be checked, and the “Reel\_\_\_\_, Frame\_\_\_\_” entries should be left blank. If the part B box is checked, and copies of assignments are not included, the “From:\_\_\_\_ To:\_\_\_\_” blank(s) must be filled in. This statement should be used the first time an assignee seeks to take action in an application under 37 CFR 3.73(b).

### **New Rejection**

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-17,20,21,23,32-35,37,38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamimura (JP 63112701; 5/17/88) or Myajima et al (JP 06321711; 11/22/94) and Fenn et al (Phytopathology, 74 (5), pp. 606-611). Kamimura teaches that metallic phthalocyanine and/or its derivatives act as microbicides to control the growth of microorganisms. Kamimura's abstract indicates that said phthalocyanine possesses fungicidal activity (abstract). Myajima et al teach that phthalocyanine - iron act as microbicides. Myajima et al.'s abstract indicate that said phthalocyanine possesses fungicidal activity (abstract). Neither Kamimura nor Myajima et al teach the composition comprising phosphorous acid or aluminum ethyl phosphite (fosetyl-Al). However, Fenn teaches a fungicidal composition comprising phosphorous acid or fosetyl-Al. See abstract. It would have been obvious to modify the composition taught by Kamimura or Myajima et al to include the phosphorous acid or fosetyl-Al taught by Fenn. One would have been motivated to do this since references individually teach fungicidal compositions. The references do not disclose the instantly named phthalocyanine compounds such as pigment blue 15 or the instant amounts of phthalocyanine and phosphorous acid or fosetyl-Al. It would have been obvious to one having ordinary skill in the art to employ pigment blue 15. One would have been motivated to do this since pigment blue 15 is a species in the phthalocyanine compound genus. Species within the same genus would have been expected to possess the same or similar chemical and physical properties and therefore, exhibit similar results when employed in a method of application. The combination of references excludes an ethylenebisdithiocarbamate contact fungicide which is a requirement of the present claims. With



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respect to the instant amount of phthalocyanine and fosetyl-Al or phosphorous acid, one having ordinary skill in the art would have been expected to determine the optimum amount of phthalocyanine and fosetyl-Al or phosphorous acid. One would have been motivated to do this in order to make a composition that would have been most effective in controlling fungal growth. With respect to the physical form of the composition one would have expected all physical forms of the actives to be effective absent a showing of unexpected results. With respect to the term "synergistic" used in the claims to describe the combined activity of said phthalocyanine and fosetyl-Al or phosphorous compound, the Examiner points out that all of the examples showing synergism provided by Applicant include mancozeb (specification and declarations). The Examiner further points out that Applicant does not provide examples showing synergism for a combination comprising only phosphorous acid or fosetyl-Al plus a phthalocyanine lacking the fungicide (mancozeb).

#### ***Other Matters***

The claims as presented previously have (pending) in front of them.

If the claims are original claims and have not been amended, they should be identified as "Original" rather than "pending".

If the original claims have been amended, the claims should be identified as "First amended", "Twice amended", etc.

If the claims are "new", the claims should be identified as "New".

#### ***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alton N. Pryor/  
Primary Examiner, Art Unit 1616